

**REMARKS**

The above Amendments and these Remarks are in reply to the Office Action mailed December 11, 2003. A petition and fee for a one month extension of time and fee for additional claims is included with this amendment. The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

On Wednesday, April 7, Examiner Jinsong Hu extended the courtesy of an interview to Applicant's representative, Bryon Wasserman. Examiner Hu indicated that a draft amendment similar to the presently submitted amendment would differentiate the pending claims from the cited art. The presently submitted amendment and arguments related thereto are discussed below.

Claims 1-18 were pending in the Application prior to the outstanding Office Action. In the Office Action, the Examiner rejected claims 1-18. Applicant has amended claims 1 and 11 and added claims 19-25. Claims 1-25 are now pending. Claims 1-7, 15, and 18 stand rejected under 35 U.S.C 102(e) as anticipated by Baker U.S. Patent No. 5,920,303. Applicant respectfully traverses the rejection. Claim 1, as amended, recites:

- (a) accessing a conversation representation;
- (b) selecting the conversation representation;
- (c) obtaining an internal representation of a conversation element associated with the conversation representation; and
- (d) generating an audible utterance based on the internal conversation element, wherein the audible utterance comprises a statement to be transmitted to a remote party as part of an ongoing conversation.

New claim 19 also recites these features. The claimed invention is directed towards a communication method that accepts conversation representation selections, obtains a conversation element associated with the conversation representation selections, and generates an audible utterance to be transmitted to a remote party as part of an ongoing communication with the remote party.

Baker, which discloses an assisted speech generation device is deficient of any mention of these features. The system of Baker is configured to receive selections of word elements which can be displayed or output to a remote speaker. Baker does not disclose or suggest that the conversation elements are transmitted to a remote party as part of an ongoing conversation with the remote party.

Claim 11 additionally recites that the audible emission is configured to inform the remote party that a local party is unable to continue an ongoing conversation. This feature enables a user of the claimed invention to conveniently notify a remote party that he is unable to continue communicating with the remote party without speaking. Baker fails to disclose or suggest this feature.

With regards to claims 8-14, even though the Examiner concedes that Baker does not teach the steps of altering, deleting, or downloading the conversation representation and element, the Examiner states that it would be obvious to one skilled in the art to add these features to Baker. However, the Examiner, does not cite any explicit or implicit suggestions to add the new features within the text of Baker. The Examiner provides a *benefit* for adding these features, but such a benefit is insufficient to render a claim obvious. *Any* feature having patentable utility is beneficial, however such a benefit is insufficient to render the addition of the feature obvious to one skilled in the art. The Federal Circuit has stated "The mere fact that the prior art may be modified in the

manner suggested by the Examiner does not make the modification obvious *unless the prior art suggested the desirability of the modification*..... it is impermissible to use the claimed invention to piece together the prior art so that the claimed invention is rendered obvious". *In re Fritch*, 972 F.2d 1260 (Fed. Cir. 1992)

In fact, several of the claimed features are incompatible with the apparatus disclosed in Baker. For example, despite providing a detailed physical apparatus through which the invention operates, Baker does not disclose any manner of recording mechanism within the physical apparatus. Thus a user of the system of Baker would be unable to modify the conversation elements or to generate new elements.

With regards to claim 19, in addition to the subject matter of claim 1, claim 19 recites that the conversation element comprises a complete statement. Baker, which discloses a modified keyboard system with individual words and word parts, is deficient of any mention of this feature.

With regards to claims 20-25, these claims recite statements to be transmitted to a remote party. In addition to containing the patently distinguishable subject matter of claim 19, these claims recite separate, patently distinguishable subject matter.


The references cited by the Examiner but not relied upon have been reviewed, but are not believed to render the claims unpatentable, either singly or in combination.

In light of the above, it is respectfully submitted that all of the claims now pending in the subject patent application should be allowable, and a Notice of Allowance is requested. The Examiner is respectfully requested to telephone the undersigned if he can assist in any way in expediting issuance of a patent.

The Commissioner is authorized to charge any underpayment or credit any overpayment to Deposit Account No. 06-1325 for any matter in connection with this response, including any fee for extension of time, which may be required.

Respectfully submitted,

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